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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,090	07/15/2002	Guillaume Desurmont	6680-010	4942

7590 01/29/2003

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EXAMINER

ASINOVSKY, OLGA NMN

ART UNIT PAPER NUMBER

1711

DATE MAILED: 01/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/937,090

Applicant(s)

Desurmont et al

Examiner

Olga Asinovsky

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1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 15, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26-55 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

The supplemental preliminary amendment dated on 1/30/02 is noted.

The present claims are 26-55.

#### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 26-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,698,634. Although

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the conflicting claims are not identical, they are not patentably distinct from each other because claims of Patent 5,698,634 discloses a process for preparing a block copolymer of an alpha-olefin having 3 or more carbon atoms using a trivalent rare earth metal complex, and then polymerizing a vinyl compound or a lactone to said alpha-olefin polymer, wherein the trivalent rare earth metal complex is a compound represented by the formula (3) and Ln is yttrium=Y, claim 1 in Patent 5,698,634. The metal complex of the formula (3) in the Patent '634 is readable in the present claims. A block copolymer produced by polymerizing of an alpha-olefin=first monomer, and then polymerizing a vinyl compound such as an unsaturated carboxylic acid is within the scope in the present claims. The difference is that Patent '634 does not call a catalyst of formula (3) as a hydride complex. It would have been obvious to one of ordinary skill in the art to use a process for producing a block copolymer in claims 1-9 in the Patent '634 by using a metal complex of the formula (3) and to consider that a said catalyst is working equally well within the same expectation for being a metal complex catalyst for preparing a block copolymer since the active donor is produced from a compound selected from the group consisting of a ketone, an ester, an ether and an amine.

3.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner et al U.S. Patent 5,391,629.

The independent claim 47 discloses a copolymer comprising a first block of a crystalline polyolefin derived from an alpha-olefin containing from 3 to 20 carbon atoms and a second block of an amorphous polyolefin, with the exception of a PP/EP copolymer having a molecular mass  $M_n$  of less than or equal to 16 000 and a polydispersity index of between 3 and 3.3. A copolymer can have the structure as a PP/EP copolymer for the present claim 48.

Turner discloses a diblock copolymer wherein a first propylene block can be produced, then crystalline HDPE block is obtained, column 9, lines 15-22, for the present claims 47, 48 and 51. A first propylene block can be isotactic polypropylene produced by a metallocene catalyst, column 8, lines 16-17, for the present claim 52. The average molecular weight of the polymer segments can be in the range of from 100 to 1,000,000, and the molecular weight distributions are preferably about 5 or less, column 7, lines 6-13 and claim 1 at column 16. Reference discloses wide varieties of block copolymers having diblock structures. It would have been obvious to one of ordinary skill in the art to use a process for producing a polyolefin copolymer having a first block derived from an isotactic polypropylene and a second block derived from an amorphous or crystalline polyolefin in Turner's invention by using a metallocene catalyst because reference

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discloses that the block copolymers can be obtained having the desired properties, since the desired properties are depending on the selected catalyst and the process's conditions for producing the copolymer having the predicted properties.

The prior art under category X and Y cited in the search report PCT/FR00/00614 has been considered. The prior art is relevant to show the state of the art knowledge.

There is no Form PTO 1449.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is (703) 308-0041. The examiner can normally be reached on Monday to Friday from 9am to 5:30pm.

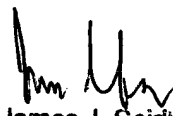
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718 and (703)872-9311 after final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

O-A

O.A.

January 21, 2003

  
James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700